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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,434	11/14/2001	Jean-Baptiste Saunier	2365-33	6672

7590

08/06/2003

NIXON & VANDERHYE P.C.  
8th Floor  
1100 North Glebe Road  
Arlington, VA 22201

EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 08/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/987,434

Applicant(s)

JEAN-BAPTISTE

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 1-19 are pending in this application.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21-33 of U.S. Patent No. 6,537,329 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are drawn to the similar methods for dyeing hair using similar dyeing compositions and similar multi-compartment devices or kits for dyeing hair wherein the compositions comprising similar ingredients having similar properties differing only in that the instant claims recite a coupler compound of the claimed formula (I), in which a heterocyclic radical may be attached to the claimed formula and wherein the reference's formula (I), a cationic group that is represented by a formula (II) in which B represents a linear or branched alkyl radical, and D is chosen from the groups of formulae (III) and (IV) is required to be attached to the formula.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a dyeing composition by incorporating the coupler

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compound of the formula (I) as taught by the claims of the US' 329, because there is a similarities between the coupler of the US Patent and the coupler of the claimed invention, wherein the claimed formula (I), R1 represents a linear or branched radical comprising 1 to 15 carbon atoms and forming one or more carbonaceous ring comprising from 3 to 7 ring that comprise one or more double bonds resulting in aromatic groups and one or more carbon can replaced by an oxygen, nitrogen or sulfur as claimed in claim 1. Further, claim 2 also define R1 to be an A1 group that composed of a linear or branched C1 to C8 alkyl radical and carry one or two double bonds which may be substituted by a group chosen from an A3 that composed of heteroaromatic groups and due to the their addition salts with an acid the cationic radical is formed, and, thus, a person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed. Absent unexpected results.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vidal (WO 00/42971).

Vidal (WO' 971) teaches a hair dyeing composition comprising at least one oxidation base and at least one coupler chosen from a compound of a formula (I), which is similar to the claimed formula (I), when in the reference's formula (I), R1-R5 and Y represent hydrogen atoms as claimed in claims 1-4 and 6-11 (see page 38, lines 1-25, page 39, lines 1-30 and formula (I)),

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R4 represents a radical containing 1 to 20 carbon atoms which including the methyl group as claimed in claim 5 (see page 39, line 10), R1, R3-R5 and Y represent hydrogen atoms and R2 represents a radical containing 1 to 20 carbon atoms which including the methyl group as claimed in claim 12 (see page 38, line 21-22). The composition also comprises a compound of N-(2-hydroxy-4-aminophenyl)methanesulphonamide as claimed in claim 13 (see page 34, lines 8-9), addition salts with an acid chosen from hydrochlorides and sulfates as claimed in claim 15 (see page 59, claim 28), wherein the coupler of the reference's formula (I), presented in the amount of 0.0001 to 10% which is within the claimed range as claimed in claim 14 (see page 59, claim 27). Vidal further, teaches a method for dyeing hair which is similar to the claimed method, wherein the reference's method comprises applying to the hair a dyeing composition as described above after mixing with an oxidizing agents such as hydrogen peroxide or enzymes such as laccases or peroxidases as claimed in claims 16-18 (see page 32, line 20 and page 60, claims 29-30). Vidal furthermore, teaches a mult-compartment device or kit for dyeing hair, which is similar to the kit as claimed in claim 19 (see page 60, claim 31).

The claims differ from the reference by reciting a dyeing composition that comprises a coupler compound represented by a claimed formula (I), in which a heterocyclic radical may attached to the claimed formula.

However, It would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition because the reference teaches compounds structurally similar to those claimed, and, thus, one having ordinary skill in the art would have obtained the recited claimed compounds within the general disclosure of the reference with the reasonable expectation of achieving successful composition for dyeing hair. Also, the similarities

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in chemical structure between the prior art and the claimed compounds and which have similar utilities establish a prima facie case of obviousness. (In re Payne, 203VSPQ 245).

*Conclusion*

The remaining references listed on form 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Eisa Elhilo  
Patent Examiner  
Art Unit 1751

August 3, 2003